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UNITED STATES PATENT AND TRADEMARK OFFICE

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09/902,407	07/10/2001	Yasser alSafadi	US010319	8261

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BOVEJA, NAMRATA

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/902,407	ALSAFADI ET AL.
	Examiner	Art Unit	
	Namrata Boveja	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>06 June 2007</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) <u>15</u> is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-14 and 20</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>1/11/02 and 7/10/01</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to communication filed on 06/06/2007.

2.   Claim 15 has been cancelled by the Applicant. Claims 1-14 and 16-20 are

presented for examination.

3.   Amendments to claims 1, 2, 5-9, 13, 14, and 16-20 have been received and

entered.

<u>Claim Rejections - 35 USC § 112</u>

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.   *Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply*

with the written description requirement. The claim(s) contains subject matter, which

was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. Specifically, the claim introduces the limitation of

generating a ripeness indicator associated with the operation of the recommendation-

generating process, and this constitutes new matter, as this claim limitation is not

supported by the specification. According to the Applicant specification on page 11 and

Figure 7, the user would like to know how "ripe" is the retrieved recommendation, and

so the ripeness indicator relates to the ripeness of the result and not to the operation of

the recommendation-generating process as claimed.

5.   *The second paragraph of 35 U.S.C. 112 is directed to requirements for the*

claims:

> *The specification shall conclude with one or more claims particularly pointing out and*
> *distinctly claiming the subject matter which the applicant regards as his invention.*
> *There are two separate requirements set forth in this paragraph:*
> *(A)   the claims must set forth the subject matter that applicants regard as their*
> *invention; and*
> *(B)   the claims must particularly point out and distinctly define the metes and*
> *bounds of the subject matter that will be protected by the patent grant.*

Claim 17 is rejected under 35 U.S.C. 112 second paragraph.

Claim 17 recites "generating a ripeness indicator associated with the operation of

the recommendation-generating process as limited by the one or more pre-defined,

user-selectable limiting factors." It is unclear what it meant by the ripeness indicator

being associated with the operation of the recommendation-generating process. It is

interpreted to mean that the ripeness indicator is generated based on how "ripe" the

resulting recommendation is to the user based on the Applicant specification on page

11 and Figure 7. Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office

action:

> (a) the invention was known or used by others in this country, or patented or described in a printed
> publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6.   Claims 1-3, 5, 8-10, 12-14, 16, 17, and 20, are rejected under 102(a) as being

anticipated by the LexisNexis website printouts (see attached pages) (hereinafter

Lexis).

In reference to claim 1, the Lexis teaches a method for use in an information processing system for generating a recommendation at a processing device, the method comprising: pre-defining one or more user-selectable limiting factors in a recommender system that limit *optimal processing* characteristics *(i.e. per page 8 of the Applicant's specification, optimal or near optimal output is based on the user input of ASAP versus take your time factors, and per Lexis, optimal results can be achieved by selecting all the applicable databases and less than optimal results can be achieved by selecting one database for searching by the user)* of a recommendation-generating process implemented in the recommender system (i.e. giving the user the option to select the following factors: KWIC, FULL, All Pos, All Neg, Show Symbols, and Custom Restrictions – Jurisdictions *(i.e. different databases can be searched)*, Headnotes, and Date) (pages 2-5, 9, 11-15, 22, and 23); receiving an input in the recommender system (i.e. receiving a citation, party names, keywords) (pages 5, 6, 9, 12-15, 22, and 23); processing the input in the recommender system *by the recommendation generating process (i.e. input has to be processed with a recommendation generating process to provide the results)* in accordance with the one or more pre-defined, user-selectable limiting factors (i.e. applying the factors to the search input) (pages 7, 17, and 22); and generating an output recommendation based at least in part on the processed input (i.e. presenting the user with the results) *(pages 7, 8, 17, and 22), the output recommendation being generated in accordance with an optimal processing as limited by the pre-defined one or more user-selectable limiting factors (i.e. the user selected limiting factors are used to produce optimally processed results where the user is given*

the option to select the following factors: KWIC, FULL, All Pos, All Neg, Show Symbols,

and Custom Restrictions – Jurisdictions (i.e. different databases can be searched),

Headnotes, and Date) (pages 2-5, 9, 11-15, 22, and 23).

7.   In reference to claims 2, 13, and 16, Lexis teaches the method further including

generating a ripeness indicator associated with the output recommendation, the

ripeness indicator being indicative of the one or more user-selectable limiting factors

(pages 3, 4, and 21-23).

8.   In reference to claim 3, Lexis teaches the method wherein the ripeness indicator

comprises a visual indicator having at least a first state corresponding to a first color

and a second state corresponding to a second color (pages 3, 4, and 21-23).

9.   In reference to claim 5, Lexis teaches the method wherein at least one of the

user-selectable limiting factors is selectable via a user interface of the processing

device (pages 2-5, 9, 11-15, 22, and 23).

10.   In reference to claims 8 and 20, Lexis teaches the method wherein at least one

of the user-selectable limiting factors comprises a specified limit on a quality measure

associated with the output recommendation (i.e. all positive treatment and all negative

treatment) (pages 4 and 12).

11.   In reference to claim 9, Lexis teaches the method wherein at least one of the

user-selectable limiting factors is selectable by the user as one of the plurality of points

along a scale from a low level of the limiting factor to a high level of the limiting factor

(i.e. one jurisdiction to all jurisdictions) (pages 12-14).

12.   In reference to claim 10, Lexis teaches the method wherein the processing

device is configured for presentation of the output recommendation in a visually

perceptible manner on a display of the device (pages 1-17 and 21-23).

13.   In reference to claim 12, Lexis teaches the method wherein the processing

device comprises at least one of a desktop or portable personal computer (i.e. the Lexis

site is accessed and utilized by using a computer) (pages 1-23), a personal digital

assistant, wireless telephone and a set top box.

14.   In reference to claim 14, Lexis teaches an apparatus for use in generating a

recommendation in a processing device information processing system, the apparatus

comprising: memory for storing profile associated with the device (i.e. it is inherent that

there is a memory for storing the profile, since the user is being asked to login using a

login id which the user had to create previously during registration and which is currently

stored in the system along with information such as student access versus professor

access and e-mail information) (page 1); and a processor coupled to the memory, the

processor being operative to process an input and one or more limiting factors in an

implementation of a recommender system (pages 5, 6, 9, 12-15, 22, and 23), the one or

more limiting factors being pre-defined and selectable by user of the device prior to the

processor processing the input (pages 7, 9, 12-15, 17, and 22), the one or more limiting

factors defining one or more *processing* characteristics *relative to an optimal processing*

characteristic (i.e. per page 8 of the Applicant's specification, optimal or near optimal

output is based on the user input of ASAP versus take your time factors, and per Lexis,

optimal results can be achieved by selecting all the applicable databases and less than

optimal results can be achieved by selecting one database for searching by the user) of

a recommendation generating process implemented in the recommender system, and

to generate the recommendation based at least in part on the input the stored profile

associated with the device (i.e. inherent because Lexis limits certain kinds of access to

features for students that it allows Professors to access based on who logs into Lexis)

(page 1), *the processing* characteristic of the recommendation generating process being

configured by the recommender system in accordance with the one or more limiting

factors (pages 7, 8, 17, and 22) *that limit the recommendation-generating process*

relative to the optimal processing characteristic (i.e. in Lexis, selecting the processing

characteristic of a given jurisdiction on page 23, limits the generation of the

recommendation to be from the database associated with that specific jurisdiction)

(page 23).

15.   **Disclaimer:** Claim 17 was found to be deficient under U.S.C. 112 second and

first. To the extent the claimed invention was understood, the following art was applied.

       In reference to claim 17, Lexis teaches a method for use in an information

processing system for generating a recommendation at a processing device, the

method comprising: receiving an input in a recommender system from a source

separate from the processing device (i.e. from a user, a keyboard, or a mouse) (page

6), the recommender system operating on a recommendation-generating process

(pages 7, 17, and 22); processing the input in the recommender system in accordance

with one or more pre-defined, user-selectable factors that limit characteristics of the

recommendation-generating process (pages 7, 8, 17, and 22); generating an output

recommendation based on the processed input (pages 7, 8, 17, and 22); and generating

a ripeness indicator associated with the *operation of the recommendation-generating*

process (i.e. per the Applicant specification on page 11 and Figure 7, the user would

like to know how ripe is the recommendation as indicated by the ripeness indicator, and

so the ripeness indicator indicates the ripeness of the recommendation result) as

limited by the one or more pre-defined, user- selectable limiting factors (pages 3, 4, and

21-23).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

16.   Claims 6, 7, 18, and 19 are rejected under U.S.C. 103(a) as being unpatentable

over Lexis in view of Shaw ("Inventing the 'Paper' of Figure...Newspapers and the

Future: First of Two Part. Next: Fax, phones, fear and the future." Los Angeles Times.

June 2, 1991. Pages 1-8 hereinafter Shaw).

In reference to claims 6 and 18, Lexis does not does not teach the method

wherein the limiting factor comprises a specified limit on an amount of time that may be

spent by the recommender system in generating the output recommendation. Shaw

teaches the method wherein the limiting factor comprises a specified limit on an amount

of time that may be spent by the recommender system in generating the output

recommendation (Page 2 lines 33-34 and Page 3 lines 1-3). It would have been obvious to modify Lexis wherein the limiting factor comprises a specified limit on an amount of time that may be spent by the recommender system in generating the output recommendation to enable users to receive smaller or greater number of result listings which best match the user criteria according to how much time the user has available to view the search results.

17.   In reference to claims 7 and 19, Lexis does not does not teach the method wherein the limiting factor comprises a specified limit on an amount of power consumption utilized (this is also considered to be equal to the amount of time that may be spent by the recommender system in generating the output recommendation, since in effect if you are running out of power, you are running out of the amount of time you have available to access the device prior to shut down as a result of depleting the power supply) in conjunction with generating the output recommendation. Shaw teaches the method wherein the limiting factor comprises a specified limit on an amount of time that may be spent by the recommender system in generating the output recommendation (Page 2 lines 33-34 and Page 3 lines 1-3). It would have been obvious to modify Lexis wherein the limiting factor comprises a specified limit on an amount of time that may be spent by the recommender system in generating the output recommendation to enable users to receive smaller or greater number of result listings which best match the user criteria according to how much time the user has available to view the search results.

18.   Claims 4 and 11 are rejected under U.S.C. 103(a) as being unpatentable over Lexis in view of Official Notice.

In reference to claims 4 and 11, Lexis teaches the method comprising of a visual ripeness indicator (pages 3, 4, and 21-23). Lexis does not teach the ripeness indicator to be audible and presenting the information using a speaker associated with the device. In reference to claim 4, Official Notice is taken that it is old and well known to use an audible indicator to indicate the existence *and degree* of a match in the case of an announcement of winning lottery numbers *or bingo numbers* for example and to play this information using computer speakers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of an audio indicator in the ripeness indicator and computer speakers to enable users to audibly determine the *degree of* match of *the* results *in relation to a* given criteria, since some people may want to receive this information by the use of audio and other*s* may prefer to view the information graphically.

Response to Arguments

19.   After careful review of Applicant's remarks/arguments filed on 06/06/2007, the Applicant's arguments with respect to claims 1-14 and 16-20 are presented for examination and have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the claims have both been entered and considered.

20.   Applicant's amendment to claim 17 resulted in new 35 U.S.C. 112 first and second paragraph rejections as detailed in the body of the office action.

21.   In reference to claim 1, Applicant argues that Lexis does not teach a recommender system that limits optimal processing characteristics in accordance with one or more user-selectable limiting factors. The Examiner respectfully disagrees with

the Applicant and would like to first point the Applicant to page 8 of the Applicant's

specification where it is stated that optimal or near optimal output is based on the user

input of ASAP versus take your time factors. Similarly, in Lexis, optimal results can be

achieved by the user selecting all the applicable databases and less than optimal

results can be achieved by selecting one database for searching by the user as done

when a user selects a specific jurisdiction database for a search (page 23). Hence,

Lexis teaches the user selecting the factor of for example specific jurisdictions to

produce either optimal or less than optimal results.

22.   Applicant argues that one skilled in the art would not want to limit the processing

of a Lexis search for a given input relative to an optimal processing characteristic

because then the quality of the generated recommendation would be suspect. The

Examiner respectfully disagrees with line of reasoning. One skilled in the art would

indeed want to limit the processing of a Lexis search, since the more databases are

search, the higher the cost of the search to the subscriber. Furthermore, the user may

also want to select different databases depending on what type of authority the user is

searching for such as mandatory and persuasive.

23.   In reference to claim 3, the Applicant argues that Lexis fails to show anything

close to a visual indicator for a ripeness indicator, since the different colors are merely

convenient status indicators of different types of precedent. The Examiner respectfully

disagrees with the Applicant, since the Shepard's Signal Indicators in Lexis are color-

coded symbols, and hence are visual indicators (page 23). Additionally, claim 3 states

"the method wherein the ripeness indicator comprises a visual indicator having at least

a first state corresponding to a first color and a second state corresponding to a second

color." And, in Lexis, the red hexagon shaped visual indicator corresponds to the state

of having negative treatment, the yellow triangle visual indicator corresponds to the

state of having possible negative treatment, and the blue tilted square with a plus sign

corresponds to the state of having positive treatment. So, the symbols in Lexis are

depicting how ripe the results are, since a blue positive indicator shows that this case

has given positive treatment to the user's case.

24.   In reference to claims 4 and 11, the Applicant argues that with respect to the

Official Notice, the ripeness indicator does not audibly resonate with a particular match

per se, but instead is indicative of a processing ripeness relative to the one or more

limiting factors during the processing of the recommendation generation. With respect

to his, the Examiner would like to point the Applicant to page 11 and Figure 7 of the

Applicant specification, where it is indicated that the ripeness indicator allows the user

would to know how "ripe" is the retrieved recommendation, and so the ripeness indicator

relates to the ripeness of the result and not to the operation of the recommendation-

generating process. The Examiner meant match in the Official Notice to not just mean

a particular match but also how close of a match the result is for the user. The

Examiner has clarified this in the Official Notice. For example, if someone is

announcing winning Bingo numbers, match can mean the exact match of one number in

a row or column, or it can mean how close the user is to matching all the numbers in a

given row or column (i.e. one more number is needed to win).

25.   In reference to claims 6, 7, 18, and 19, the Applicant argues that the user-

selectable limiting factors of the present invention are processing-based factors and not

recommendation-based factors. With respect to this, the Examiner would like to point

out the Applicant that factors such as selecting which jurisdictional databases to search

in Lexis on page 23 are also processing-based factors, since depending on which

jurisdictional database is selected, the processing is conducted on that particular

database instead of all the other databases. Therefore, Lexis recommendation is

generated based on a processing criterion as well, since specific databases for search

can be selected to save processing time.

26.   Applicants additional remarks are addressed to new limitations in the claims and

have been addressed in the rejection necessitated by the amendments.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Namrata (Pinky) Boveja whose telephone number is

571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the

Examiner's Supervisor, Eric Stamber can be reached on 571-272-6724. The **Central**

Fax Number for the organization where this application or proceeding is assigned is

571-273-8300.

Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 1866-217-9197 (toll-free).

NB

July 17th, 2007

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TECHNOLOGY CENTER 36